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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,373	09/04/2003	Vincenzo Valentio DiLuoffo	AUS920030651US1	8456

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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EX

Office Action Summary

Application No.

10/655,373

Applicant(s)

DILUOFFO ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 18 January 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3 and 7-11, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich (US 2003/0149576, cited in the previous Office Action) in view of Allen et al. (US 2004/0124246).

Sunyich teaches storing user preference information on a wireless storage device; selectively transmitting the user preference information from the wireless storage device to a

receiving device at a service facility; and transmitting the user preference information from the receiving device to a control system at the service facility for controlling selected services in accordance with the user preference information (paragraph [0025]+ and FIG. 1). The Examiner notes that it is understood that upon reading the card, that the preference information is sent to a receiving device (the card is read), and the preference information is sent to a control system, broadly interpreted as computer program/system that takes the data from the card and applies it to the room so that the room preferences (22) can be implemented. Sunyich teaches direct user manual input to the wireless storage device to modify the user preference information (paragraph [0020] that teaches that a kiosk at the hotel allows hotel guests to make preference changes. The use of a keypad of the kiosk is an obvious expedient to provide a user interface. Therefore, selection of a keypad is well within the skill in the art. Additionally, the Examiner notes that Sunyich teaches that the card itself can store the preference data (as opposed to the data being stored on a central storage separate from the card for faster access) (paragraph [0026]+).

Sunyich is silent to selective user activation of an on-off function switch on the wireless device (card), and enabling direct user manual (interpreted as through the card itself, not a reader/writer) input to the wireless storage device (card) using a real or virtual keypad function of user selected indicia including alpha-numeric characters to modify the user preference information.

Allen et al. teaches a user actuation of an on-off function switch on the wireless storage device (power key 214, interpreted as a on-off switch; FIG. 2). Additionally, Allen et al. teaches manual input directly into the card (the keypad is part of the card) to modify preference information on the card (FIG. 2 and FIG. 14).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Sunyich with those of Allen et al.

One would have been motivated to do this in order to provide control means to control when the card is actuated, increasing security of the card while also extending batter life, while also providing means to alter card data directly on the card itself, therefore providing convenience to the user, instead of direct input into the card through a reader.

Re claim 2, the card is a smart card, as discussed above. The Examiner notes that it is well known and conventional to use non-volatile programmable memory in the card (see US 2004/0031853 as an example). It would be within the skill in the art to select such a memory in order to enable the memory to be personalized and not lost when powered down, as known in the art.

Re claim 3, Sunyich teaches storing and reading from the proximity card, which is broadly interpreted as transmitting and receiving information, since it is well known and conventional that contactless smart cards/proximity cards, can include transceiver/communication means to send and receive information. Such teachings are well known and conventional in the art, such as RFID cards, contactless cards, proximity card, etc. It would have been well within the skill in the art to select a proximity/transceiver card in order to add convenience to the user by not having to directly present a card, while also reducing wear on the card itself (as the card does not physically contact a reader).

Re claim 7, the service is a lodging facility (hotel) as described above. Re FIG. 1, Sunyich teaches assigning a lodging unit to the user.

Re claims 8-9, Sunyich teaches preferred temperature settings (FIG. 1).

Re claim 10, Sunyich teaches wake up settings (paragraph [0037]).

Re claim 11, Sunyich teaches that the user can be checked in and open the door to the room with a smart card, all in one step (paragraph [0029] +). The Examiner also notes that temporarily programming cards to open hotel doors (for duration of stay) is well known and conventional in the art in order to provide additional security by being able to change the locks on the doors with different codes, while also reducing costs, as when a card is lost the lock does not need to be replaced as when physical keys are lost.

Re claim 15, Sunyich teaches predetermined reservation information (paragraph [0024] +), interpreted to include arrive and leaving information, as is conventional in the art of reservations. Sunyich teaches the control system can automatically initiate user checkout processing in accordance with the predetermined reservation information (paragraph [0042] +) which teaches that user checks out by swiping the card through a reader. As the card is swiped, the user is checked out, which is interpreted as the system automatically checkout out the user based on the stored card information (reservation information). The Examiner notes it is well known and conventional in the art for users to checkout of hotels by swiping a card through a reader, where the reader automatically checks the user out, using the card information. As the Applicant has not specified that the checkout process be done without swiping the card through a reader, such an interpretation is acceptable.

Re claim 18, Sunyich teaches a smart card, but is silent to flash memory. The Examiner notes that it is well known and conventional to use flash memory (see US 2004/0031853). One would have been motivated to use such a well known type of memory since it is easily personalized.

Re claims 19-20, the limitations have been discussed above re claim 1. The prior art teaches the card is the size of a credit card. The Examiner notes that it is inherent in the prior art teachings that a processing means is coupled to the card for processing information, as the data is processed.

3. Claims 4-6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich/Allen et al., as applied to claim 1 above, further in view of Tsurukawa et al. (JP 02000357272A, cited in the previous Office Action).

The teachings of Sunyich/Allen et al. have been discussed above.

The teachings of Sunyich/Allen et al. have been discussed above, including unlocking doors through a reader at the entrance, upon receipt of information. Re claims 4-5 it is well known and obvious for smart cards to include a processor and transceiver (processing and communication means) to process and send/receive data as is conventional in the art or smart cards (smart cards conventionally have processors/CPU's to process data). Re claim 6, Sunyich teaches storing user preferences in a database before entering a hotel, through a website or computer/software, or alternatively, the database can be stored on the card itself (as mentioned above). Accordingly, when stored on the card itself, it is therefore obvious that user input means must exist in order for user information to be input to the card (Sunyich even teaches storing preferences (input means) on a user card before entering the room/hotel (see claim 10)). Therefore, it is obvious to have user input means on a smart card for allowing updating/storing of data, as when used in a computer system or card reading/writing system, (as is well known and conventional in the art), as an alternative to storing such preferences on a remote database, in order to reduce the amount of time/interaction required to check in (as direct card scanning is not

required). The Examiner notes that writing user input data to smart cards for personalization/updating is well known in the art. Re claim 4, Allen et al. teaches the display displays user input and user preference information (FIG. 14).

Sunyich/Allen et al. are silent to a display on the card displaying received information and transceiver communicated information including the lodging unit. The Examiner notes that the unlocking of assigned units/rooms has been discussed above.

Tsurukawa et al. teaches a contactless smart card with a display means for displaying received data, including lodging unit (claim 2 and paragraph [0005], for example). Further, the Examiner notes that Tsurukawa et al. also includes input means for enabling user input to the storage device of the card as well.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Sunyich/Allen et al. with those of Tsurukawa et al.

One would have been motivated to do this to provide the convenience of having a display means on the smart card to provide essential information to the user.

Re claim 5, the limitations have been discussed above.

4. Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Sunyich/Allen et al., as applied to claim 1 above, further in view of Hohle et al. (US 6,101,477 cited in the previous Office Action).

The teachings of Sunyich/Allen et al. have been discussed above

Sunyich/Allen et al. is silent to the service facility being a vehicle rental/airline facility for assigning a vehicle/reserved services.

Hohle et al. teaches that the smart card can include preferences for rental and airline (col 20, lines 46+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Sunyich/Allen et al. with those of Hohle et al.

One would have been motivated to do this to use preference information on a smart card to streamline registering/payment for a traveler, for example. Further, the Examiner notes that simply changing hotel information to rental car and airline information is an obvious expedient. Simply varying the type of preferences stored on a card is well within the skill in the art. If the Applicant disagrees, a restriction maybe enforced.

Response to Arguments

5. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pugliese et al. (US 2001/0016825), Nagata et al. (US 4,959,788), Gutman et al. (US 5,221,838), Wallerstein (US 5,585,787), Pitroda (US 5,590,038), Watanabe (US 5,679,939), Piosenka et al. (US 5,777,903), Claus et al. (US 5,857,079), Knowles et al. (US 5,869,819), Berg et al. (US 2002/0130187), Loewidt (US 2004/0041711), Brondrup (US 2003/0208386), and Keronen et al. (US 2004/0050933).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

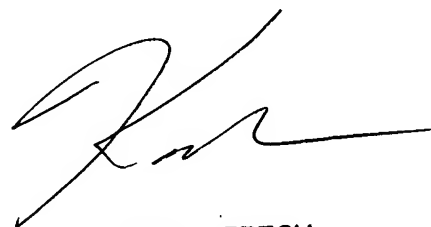
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more

clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
3/21/05



KARL D. FRECH
PRIMARY EXAMINER